REMARKS

Claims 1-5 are pending. Claim 5 has been withdrawn from consideration per the Restriction Requirement of December 16, 2003.

Applicant's Response to the Rejection under 35 USC 103(a)

Claims 1-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over ***JP 64-81874*** in view of ***Reisser et al.*** (USP 5,332,767). Applicant respectfully traverses on the basis that ***JP '874*** and ***Reisser et al.*** do not provide a *prima facia* case of obviousness within the meaning of §103.

The disclosure of the binder of polycarbonate resin and resin/agent coated metal particle are limitations of claim 1. According to the Office Action, ***JP '874*** discloses a non-metallic (carbon-black) coated in polyamine polymer and surface treated with polycarbonate binder. ***Reisser et al.*** discloses a resin coated metal particle. The Office Action maintains that it would have been obvious for one skilled in the art to take the resin coated metal of ***Reisser et al.*** and combine it with the polycarbonate binder of ***JP '874***. The Office's assertion as to motivation for the combination is to "diversify the aesthetic appearance of the ink." However, Applicant respectfully submits that there is no such teaching or suggestion in either reference.

As is well established in U.S. patent law, the mere fact that the teachings of the prior art can be combined does not establish a motivation or suggestion to combine and make the resultant combination. The prior art must suggest the desirability of the combination.

There is no teaching or suggestion in ***Reisser et al.*** that the resin coated metal particles of the invention would be useful or usable with specific binders. Likewise, there is no teaching in ***JP '874*** that diversity of aesthetic appearance would be warranted or desirable.

As described at pages 2 and 3 of the specification, the invention of this application provides an ink capable of preventing blurring of images preprinted on the decorated film or sheets upon injection molding. According to the invention of this application, the problem of blurring is solved by surface treatment of metal particles used with the printing ink with a specific resin. The ***Reisser et al.*** publication (US '767) shows a metal pigment covered with a synthetic resin, which is provided for the purpose of improving water resistance, chemical resistance, bind capability, etc., as set forth at column 2, line 53. ***JP '874*** pertains to an ink sheet dedicated to a thermal transfer printer that is an impact printer. Neither of the prior publications (which are in distinguishable technical fields over the invention of this application) describe anything about the problem to be solved and the means for achieving the same. Thus, the invention of this application would not have been obvious by combination of the references.

Further, the Applicant notes that the combination of the references would destroy the intended function of each reference. Hence, one skilled in the art would not have been motivated to make the combination. Specifically, the resin coating of each reference is specific to the function of the respective invention. In ***JP '874***, the Abstract indicates that the carbon black is coated with a polyamine or modified polyamine, and that these specific polyamines have good compatibility with various solvents, wax and resins. JP '874 states that the carbon black has a high affinity for the component of ink

binder through the polymer, and consequently the use of the ink gives high quality and excellent durability.

Consequently, ***Reisser et al.*** teaches that the resin coating of the aluminum pigment has a siloxane coating covalently bonded to the particles and a synthetic resin bonded to the siloxane coating.

Hence, ***JP '874*** requires a polyamine coating to have utility as an invention and ***Reisser et al.*** requires a siloxane coating to function. ***JP '874*** would not function with a siloxane resin coating to react properly with the polycarbonate binder. Conversely, ***Reisser et al.*** would not function without the siloxane coating. Wherefore, the references are not properly combinable because they cannot be combined without destroying their intended functions.

In regard to claim 2, Applicant notes that none of the references discloses using a flat metal particle. The Office Action states that flat particles are common in the art. However, one skilled in the art would not have been motivated to utilize flat particles, nor is there any teaching to suggest a reasonable expectation of success when using the flat particle.

In regard to claim 3, as stated above, the references require specific resin coating to function. Wherefore, they teach away from using an acrylic resin coating. Wherefore, Applicant respectfully requests favorable reconsideration.

Claim 4 is also rejected under 35 U.S.C. 103(a) as being unpatentable over ***JP 64-81874*** in view of ***Reisser et al.*** The arguments above are likewise submitted for the allowability of claim 4. Claim 4 is drawn to a printed film or sheet. Claim 4 also includes the limitations of the binder of polycarbonate resin and resin coated metal

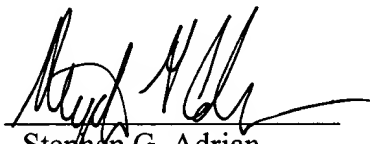
particle. Hence, for the reasons submitted in regard to claim 1 above, Applicant requests favorable reconsideration of claim 4.

For at least the foregoing reasons, it is believed that this application is now in condition for allowance. If, for any reason, it is believed that this application is not in condition for allowance, Examiner is encouraged to contact the Applicants' undersigned attorney at the telephone number below to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

By: 

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